

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Nitin Jhingen

Examiner: David J. Clark

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Sir:

Pursuant to 35 U.S.C. 134 and C.F.R. 41.41, entry of this Reply Brief in response to the Examiner's Answer in the above-identified matter is respectfully requested.

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this correspondence is being deposited with the United States Patent & Trademark Office via Electronic Filing through the United States Patent and Trademark Office e-business website, on May 17, 2010.

Dated: May 17, 2010

John S. Sensny
John S. Sensny

I. INTRODUCTION

Appellant has appealed the rejection of Claims 1-6 and 19-32 under 35 U.S.C. 103 as being unpatentable over the prior art, principally U.S. patent application publications nos. 2002/0099796 (Chou) and 2002/0046051 (Katzman, et al.).

Appellant has carefully studied the Examiner's Answer. The Examiner's Answer, though, does not change Appellant's basic position – that the rejections of the claims are improper because the prior art does not disclose or render obvious the feature of a user and an agent creating a requisition order during an instant messaging session by interactively communicating with each other during the instant message session, thereby eliminating the need to use a Web site to create the requisition order, as described in independent Claims 1, 9, 25 and 29.

II. DISCUSSION

Appellant respectfully disagrees with two important contentions made by the Examiner in the Answer. The first disagreement is about the disclosure of Katzman, et al, and the second disagreement is about whether it would have been obvious to one of ordinary skill in the art to modify Chou as the Examiner has done. In addition, the Examiner does not establish a *prima facie* case that an important limitation of the independent claims would have been obvious, and the Examiner's discussion of Claim 24 does not justify the rejection of the claim. Each of these points is discussed below.

A. The Disclosure of Katzman, et al.

The Examiner, in the Answer, contends that Katzman, et al. discloses "the user and the agent creating the requisition order during said instant messaging session by interactively communicating with each other during said instant messaging session via the instant messaging system to create the requisition order" (Examiner' Answer, page 5, lines 17-19). In support of this position, the Examiner specifically cited paragraphs 28, 33 and 39 of Katzman, et al.

A careful reading of Katzman, et al. shows that there is no disclosure of using an instant messaging session to create a requisition order. Katzman,et al. discloses an order wizard that is used to present a categorized list of goods and services, and that allows members to access local vendors. This order wizard also allows for direct communication via e-mail, chat and other technologies; and Katzman, et al. discloses in paragraph (99) that instant message may be used to confirm an order. In Katzman, et al, though, the instant message is not used to create a requisition order.

B. It would not have been obvious to modify Chou as the Examiner has done.

Appellant also respectfully disagrees with the Examiner's contention that it would have been obvious to one or ordinary skill in the art to modify the disclosure of Chou, et al to use an instant messaging system to create the requisition order.

Chou, et al. describes a system for generating a requisition order. A server computer is a central, essential component of this system. This server computer runs a user interface having a multi-tier architecture. A first tier includes client application code for initiating processing by a server application, the middle tier is object-oriented server application code, and the third tier is

shared access and data code. The server computer receives a request for the requisition of one or more items selected by the user, and verifies that each requested item may be requisitioned by a user at the work site of the requestor.

An instant messaging system has significantly less processing and memory capacity than a server. In view of this and in view of the critical, central and essential role performed by the server computer in the Chou, et al. system, it would not have been obvious to one or ordinary skill in the art to substitute an instant messaging system for the server computer of Chou, et al. to create the requisition order. One of ordinary skill in the art would not be led to change the Chou, et al system to make it less suited for its intended purpose.

The inventor of the present invention has recognized that, in an important class of situations, an instant message system, despite its limitations, is more than adequate to create a requisition order, and moreover, has the advantage of simplifying the requisition process. This recognition is absent from Chou and Katzman, et al. The only recognition that instant messaging can be used to create a requisition order is given in the present application. Thus, the Examiner is using Appellant's own teaching in hindsight to modify the prior art.

Appellant respectfully submits that it is critical to guard against the use of hindsight to read into the prior art teachings of the present invention. The Supreme Court, in KSR v. Teleflex, 127 S.Ct. 1727, 82 USPQ2d 1385 (2007), reiterated the importance of this safeguard. Specifically, the Supreme Court in KSR repeated instructions from Graham v. John Deere, 338 US1 (1966) to "guard against slipping into the use of hindsight" KSR, *supra*. In the present case, the Examiner, in arguing that it would have been obvious to have the user and the agent work together to create the requisition order using instant messaging, has engaged in hindsight

modification of the prior art – that is, reading the teaching of the present invention into that prior art.

C. The Examiner has not established a *prima facie* case that an important limitation of the independent claims would have been obvious.

Each of the independent Claims 1, 19, 25 and 29 includes the limitation that the user and the agent, by using the instant messaging session to create the requisition order, “thereby eliminate[e] the need to use a Web site” to create the requisition order (Claim 1, lines 13 and 14; claim 19, lines 16 and 17; Claim 25, lines 11 and 12; Claim 29, lines 13 and 14). This important limitation – eliminating the need to use a Web site – is not properly addressed by the Examiner in the final Rejection or in the Answer.

In the rejections of Claims 1, and 19, the Examiner does not consider this issue. In rejecting Claims 25 and 29, the Examiner pro forma lists the limitation, but no facts are cited that support the argument that the prior art discloses or renders obvious this limitation of the claims. The discussions of the portions of Claims 25 and 29 that include this limitation are basically repetitions of the discussions of the corresponding portions of Claims 1 and 19. Those discussions of Claims 1 and 19 do not take this limitation into account.

This feature of Appellant’s invention is a clear and important distinction between Appellants’ invention and the prior art. By eliminating the need to use a Web site, Appellant provides a very simple process for creating a requisition order. Chou does not eliminate the need for a Web site; Katzman, et al. does not eliminate the need for a Web site; Appellant’s invention, as claimed, does.

In light of the fact that the Examiner does not adequately address this positive, important limitation of each of the independent claims, the Examiner has not made a prima facie case of obviousness.

D. Rejection of Claim 23.

To support the rejection of Claim 24, the Examiner relies on paragraph (42) of Chou, et al. This paragraph discloses that a requestor and a site manager may be logged into a network. This site manager does not correspond to the agent described in the independent Claims 1, 19, 25 and 29 of the present application. In particular, the site manager of Chou, et al. is more in the nature of a requestor, who can enter requisitions and make inquiries. The agent described in the independent claims of the present application, works with the user actually to create the requisition order. That agent does not simply make inquiries about requisition orders. Furthermore, in the Chou, et al. system, neither the agent nor the user are logged into an instant messaging session.

Accordingly, the prior art does not disclose or render obvious the limitation, positively set forth in Claim 24, that both the user and the agent must be currently logged on to the instant messaging system in order for a message to be sent from the user to the agent.

III. CONCLUSION

For the reasons discussed above, and for the reasons set forth in Appellants' Brief, the rejections of the claims based on the combination of Chou, et al. and Katzman, et al. are not proper.

Specifically, Claims 1, 19, 23, 25 and 29 patentably distinguish over the prior art and are allowable. Claims 2-6, 23 and 24 are dependent from Claim 1 and are allowable therewith, and Claims 20-24 are dependent from, and are allowable with, Claim 19. In addition Claims 26-28 are dependent from Claim 25 and are allowable therewith; and Claims 30-32 are dependent from, and are allowable with Claim 29. In addition, Claim 24 patentably distinguished over the prior art separately from Claim 1.

The Board is thus respectfully requested to reverse the rejections of Claims 1-6 and 19-32 under 35 U.S.C. 103.

Respectfully submitted,

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John S. Sensny
John S. Sensny
Registration No. 28,757
Attorney for Applicants

Scully, Scott, Murphy & Presser, P.C.
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343

JSS:gc